

### **REMARKS**

Claims 1 and 3-19 were pending in the application. Claims 1, 3-13 and 17-19 have been cancelled without prejudice and new claims 21-35 have been added. Therefore, after entry of this amendment, claims 14-16 and 21-35 will be pending.

No new matter has been added. Support for the amendments to claims 14-16 may be found, for example, at least in original claims 1 and 14-16 and at page 3, line 15 through page 4, line 6 of the specification as originally filed. Support for new claims 21, 26 and 31 may be found, for example, at least at page 11, lines 7-11 of the specification as originally filed. Support for new claims 22, 23, 27, 28, 32 and 33 may be found, for example, at least at page 11, lines 23-32 of the specification as originally filed. Support for new claims 24, 29 and 34 may be found, for example, at least at page 15, lines 27-28 of the specification as originally filed. Support for new claim 25, 30 and 35 may be found, for example, at least at page 5, lines 11-14 of the specification as originally filed.

Cancellation of and/or amendments to the claims should in no way be construed as an acquiescence to any of the Examiner's rejections. The cancellation of and/or amendments to the claims are being made solely to expedite prosecution of the above-identified application. Applicants reserve the option to further prosecute the same or similar claims in the present or another patent application. The cancellations of and any amendments to the claims are not related to any issues of patentability.

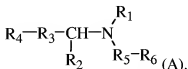
#### ***Rejection of Claims 1 and 3-19 on the Ground of Nonstatutory Obviousness-type Double Patenting***

Claims 1 and 3-19 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 5,981,598 (hereinafter "the '598 patent"). Specifically, the Examiner asserts that "[t]he claims of the instant application are within the scope of the claims of the U.S. Patent."

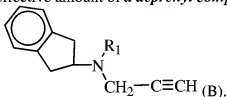
Applicants respectfully submit that this rejection is moot as it pertains to claims 1, 3-13 and 17-19 in view of the cancellation of these claims.

With regard to claims 14-16, Applicants respectfully traverse this rejection for the following reasons. Claim 1 of the '598 patent is directed to methods of treating a subject for glaucoma by administering a therapeutically effective amount of *any deprenyl compound* to the subject. Claims

2-12 of the '598 patent are directed to methods of treating glaucoma in a subject by administering a therapeutically effective amount of *a deprenyl compound of formula A*:

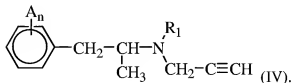
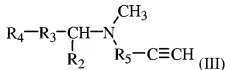
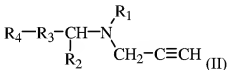


Claim 13 of the '598 patent is directed to a method of treating a subject for glaucoma by administering a therapeutically effective amount of *a deprenyl compound of the formula B*:



Finally, claims 14-16 are directed to the *specific deprenyl compounds (-)-deprenyl, (-) pargyline and (-)-desmethyldeprenyl*, respectively.

In contrast, claims 14-16 are directed to methods of treating glaucoma in a subject by *administering an effective amount of specific deprenyl compounds of formulae II, III and IV*, respectively:



Applicants respectively submit that although claims of the '598 describe methods of treating glaucoma with *any deprenyl compound*, as well as with *compounds of formula A and B*, the claims of the '598 patent do not disclose the compounds of formulae I, II or III. Moreover, a skilled artisan would not be motivated by the claims of the '598 patent to select the compounds of formulae I, II or III for the treatment of glaucoma. Accordingly, a skilled artisan would not have been

motivated by the claims of the '598 patent to use the compounds of formulae I, II or II for treating glaucoma.

Based at least on the foregoing, Applicants respectfully submit that claims 1-16 of the '598 patent fail to teach or suggest the claimed invention. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection.

### **SUMMARY**

It is respectfully submitted that this application is in condition for allowance. If there are any remaining issues or the Examiner believes that a telephone conference with Applicants' Attorney would be helpful in expediting prosecution of this application, the Examiner is invited to call the undersigned at (617) 227-7400.

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Respectfully submitted,

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